

### **REMARKS/ARGUMENTS**

Favorable reconsideration of this application, as presently amended, is respectfully requested.

Claims 18-30 are pending. Claims 1-15 and 17 were previously canceled and Claim 16 is presently canceled without prejudice or disclaimer.

The outstanding Action presented an objection to canceled Claim 1, a rejection of Claims 16, 20-24, and 27-28 under 35 U.S.C. §102(b) as being anticipated by Giannopoulos et al. (U.S. Patent No. 6,359,387, Giannopoulos), a rejection of Claims 18, 19 and 25 under 35 U.S.C. §103(a) as being unpatentable over Giannopoulos in view of Sun et al. (U.S. Patent No. 6,020,691, Sun), and a rejection of Claims 29-30 under 35 U.S.C. §103(a) as being unpatentable over Giannopoulos in view of Yoshida et al. (U.S. Published Patent Application No. 2002/0027412, Yoshida).

At the outset, it is noted that Claim 26 has been improperly omitted from the required formal statement of any rejection in the outstanding Action, even though the Office Action Summary indicates it has been rejected.

### **WITHDRAWAL OF IMPROPER ACTION AND ACTION FINALITY**

Initially, it is noted that it was the indication of allowable subject matter as to Claims 21-24 that led to Claim 21 being rewritten in independent form. The outstanding Action fails to follow established requirements as to rejecting Claim 21 and Claims 22-24 that were previously noted to contain allowable subject matter. In this respect, MPEP § 706.04 states that:

Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her office action that the claim now being rejected was previously allowed by using Form Paragraph 7.50.

¶ 7.50 Claims Previously Allowed, Now Rejected, New Art

The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]. Rejection(s) based on the newly cited reference(s) follow.

Accordingly, withdrawal of this improper Action that fails to properly withdraw the previously indicated allowability of Claims 21-24 is respectfully requested.

In addition, the outstanding Action cannot be made final as the new ground of rejection applied to the previously noted allowable subject matter of Claims 21-24 was not necessitated by the rewriting of Claim 21 in independent form.

### **RESPONSE TO OUTSTANDING ACTION**

Turning to the objection to Claim 1, this claim was canceled so that this objection is clearly moot.

To whatever extent that the outstanding Action might have intended to object to Claim 16 (for reciting “means for measuring an image of the current passing through the structure”) such an objection was not made and would be moot as this claim is now also canceled.

Turning to the rejection of Claims 16 as being anticipated by Giannopoulos, it is noted that the cancellation of Claim 16 further renders this rejection moot.

The rejection of independent Claims 21 as being anticipated by Giannopoulos is based on FIGS 1-5 that are improperly treated as relating to one arrangement. However, there is no suggestion in Giannopoulos that FIGS. 1-5 can be lumped together as FIGS. 1, 2, 4, and 5 are clearly drawn to different ballast and fluorescent lamp arrangements with FIG. 3 being drawn to a control circuit for the FIG. 1 arrangement. In this last regard, anticipation requires the citation of a single prior art reference that discloses each and every element arranged together exactly as in the claimed arrangement. See In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990); Lindemann Maschinen Fabrik GMBH v. American Hoist & Derrick Co., 221 USPQ 481

(Fed. Cir. 1984); Ex parte Gould, 6 USPQ2d 1680 (Bd. Pat. App. & Int. 1987); and Ex parte Osmond, 191 USPQ 334 (Bd. Pat. App. & Int. 1973). Thus, there must always be something in the reference directing the person skilled in the pertinent art to rearrange the expressly noted different reference embodiments into a further arrangement not set forth by the reference.

Furthermore, none of FIGS. 1-5 teach or suggest all of the Claim 21 limitations including the requirement that:

. . . the resonance means comprises a switch placed in a path from the voltage generator to the primary winding of the transformer, and a control system connected to the switch to open and close the switch over a period, wherein closing of the switch, which is closed for a duration, is triggered by choice at one of the following instants:  
at a zero crossing of the current flowing through the structure;  
when the voltage crosses a threshold voltage;  
at a threshold light level; or  
when the current flowing through the structure crosses a threshold current.

Apparently realizing that there are no teachings or suggestions in Giannopoulos of this required triggering at one of the listed instants, the outstanding Action violates the dictates of *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) that requires that in order to “establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’”(Citation omitted). Also see *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) that requires when “relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” No such basis in fact and/or technical reasoning that can be said to support the mere conclusion of inherency in the outstanding Action has been presented and the unsupported conclusion cannot be relied on standing alone.

Accordingly, withdrawal of the anticipation rejection of independent Claim 21 by Giannopoulos is respectfully requested as this reference cannot be reasonably said to teach, or even suggest, all of the limitations of this independent claim.

The rejection of dependent Claims 22-24 under 35 U.S.C. §102(b) as being anticipated by Giannopoulos is traversed at least because each of these claims directly depends on independent Claim 21 and patentably defines over Giannopoulos for the reasons noted above as to parent Claim 21.

In addition, the outstanding Action has improperly equated a concept of zero current to the entirely different recitation of dependent Claim 22 requiring triggering “at the current zero crossing,” the recitation of Claim 23 requiring triggering “when the voltage crosses the threshold voltage,” and the recitation of Claim 24 requiring “the duration of the time during which the switch is closed can be adjusted according to energy to be delivered to the structure.”

Therefore, Claims 22-24 are respectfully submitted to patentably define over Giannopoulos for the further features added by these claims that are also not taught or suggested by Giannopoulos. Accordingly, withdrawal of the anticipation rejection of Claims 22-24 by Giannopoulos is also respectfully requested.

The rejection of Claims 18, 19 and 25 under 35 U.S.C. §103(a) as being unpatentable over Giannopoulos in view of Sun and the rejection of Claims 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over Giannopoulos in view of Yoshida are traversed because Claims 18, 19, 25, 29, and 30 now all depend directly or indirectly on independent parent Claim 21 and neither Sun nor Yoshida cure the deficiencies of Giannopoulos as noted above.

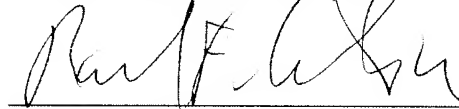
Claims 20, 26, and 27 now directly depend from Claim 21 and Claim 28 now indirectly depend from Claim 21. Accordingly these claims should be considered to be allowable for the same reasons set forth above as to parent Claim 21.

Further, Claims 18-20 and 25-30 add further features not taught or suggested by any of Giannopoulos, Giannopoulos Sun, or Yoshida and patentably define over these references taken alone or in any proper combination and withdrawal of these 35 U.S.C. §103(a) rejections is respectfully requested for this reason as well.

In view of the foregoing amendments and remarks, it is respectfully submitted that no further issues remain outstanding in the present application, and that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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